

REMARKS

Claims 1-36 are all the claims pending in the application. Claims 1-23 are withdrawn from consideration and are herein cancelled without prejudice or disclaimer. Applicant reserves the right to file a divisional application directed to the non-elected claims. By this Amendment, Applicant also amends claims 24-36 to further clarify the features set forth therein.

I. Preliminary Matters

As preliminary matters, Applicant thanks the Examiner for acknowledging Applicant's claim to foreign priority and for indicating receipt of the certified copy of the priority document. Applicant also thanks the Examiner for returning the initialed forms PTO/SB/08 submitted with the Information Disclosure Statements filed on January 14, 2005, December 28, 2006, March 19, 2007, February 27, 2008, and April 10, 2008. Applicant also thanks the Examiner for indicating acceptance of the drawing figures filed on January 14, 2005.

II. Summary of the Office Action

Claim 34 is rejected under 35 U.S.C. § 112, second paragraph and claim 35 is rejected under 35 U.S.C. § 101. Claims 24, 26, 29-32, and 34,36 are rejected under 35 U.S.C. § 102(b) and claims 25, 27, 28, and 33 are rejected under 35 U.S.C. § 103(a).

III. Claim Rejection under 35 U.S.C. § 112

Claim 34 is rejected under 35 U.S.C. § 112, second paragraph. Applicant respectfully requests the Examiner to withdraw these grounds of rejection at least in view of the self-explanatory claim amendments being made herein.

IV. Claim Rejection under 35 U.S.C. § 101

Claim 35 is rejected under 35 U.S.C. § 101 as being allegedly directed to non-statutory subject matter. Applicant respectfully requests the Examiner to withdraw these grounds of rejection at least in view of the self-explanatory claim amendments being made herein.

V. Claim Rejection under 35 U.S.C. § 102

Claims 24, 26, 29-32, and 34-36 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,039,481 to Ham (hereinafter "Ham"). Applicant respectfully traverses these grounds of rejection at least in view of the following exemplary comments.

Of these rejected claims, only claims 24 and 34-36 are independent. For example, independent claim 24 recites: "a controller that, in case that an operation through which said detection section detects the width of said recording medium is set to ON, makes said recording heat eject the liquid after performing the operation, and in case that the operation is set to OFF, makes said recording head eject the liquid without performing the operation." The Examiner alleges that the photosensor 32 of Ham discloses the detection section set forth in claim 24 (*see* page 3 of the Office Action). Applicant respectfully disagrees.

Ham discloses the carrier 30 moves leftwise along shaft 33 and then the photosensor 32 detects the light emitted from light emitting device 12b mounted on the leading end of left paper end detecting rib 12a. In Ham, when the photosensor 32 mounted on a carrier 30 detects the light generated from light emitting device 12b, a current is generated. Specifically, a distance is measured by the photosensor 32 detecting the light produced by the light emitting device 12b. A distance calculation is performed, based upon the light of the light emitting device 12b sensed by the photosensor 32 with reference to the reference position or home position of the right home position detecting rib 11a. In Ham, when the distance calculation is completed, ink bubbles are

ejected from the nozzles of the head 31 mounted on carrier 30. The ink bubbles are applied to the paper sheet as much as its width previously calculated, preventing printing exceeding the width of the paper sheet (Figs. 2A and 3A; col. 5, line 10 to col. 6, line 35).

In Ham, however, when the light emitting device is OFF, the head 31 is returned to the initial position. In other words, Ham does not disclose or suggest that when the light emitting device 32 is turned to off, the head 31 ejects liquid without the detection operation. In short, when the light emitting device is off, printing is not performed. Therefore, Ham does not disclose or suggest “a controller that, in case that an operation through which said detection section detects the width of said recording medium is set to ON, makes said recording heat eject the liquid after performing the operation, and in case that the operation is set to OFF, makes said recording head eject the liquid without performing the operation.” For at least these exemplary reasons, claim 24 is patentably distinguishable from Ham. Accordingly, Applicant respectfully requests the Examiner to withdraw this rejection of claim 24 and claims 26 and 29-32.

Next, independent claims 34-36 recite features similar to, although not necessarily coextensive with, the features argued above with respect to claim 24. Therefore, arguments presented with respect to claim 24 are respectfully submitted to apply with equal force here. For at least substantially analogous exemplary reasons, therefore, independent claims 34-36 are patentably distinguishable from (and are patentable over) Ham.

VI. Claim Rejection under 35 U.S.C. § 103(a)

Claims 25 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ham in view of U.S. Patent No. 6,234,694 to Brookner (hereinafter “Brookner”) and claim 28 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ham in view of U.S. Patent No.

6,213,659 to Elgee (hereinafter "Elgee"). Applicant respectfully traverses these grounds of rejection at least in view of the following exemplary comments.

Claims 25, 27, and 28 depend on claim 24. Applicant has already demonstrated that Ham does not meet all the requirements of independent claim 24. Brookner is relied upon only for its alleged disclosure of setting operations using a display screen and Elgee is relied upon only for its disclosure of the setting section. Clearly, Brookner and Elgee do not compensate for the above-identified deficiencies of Ham. Together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claim 24. Since claims 25, 27, and 28 depend on claim 24, they are patentable at least by virtue of their dependency.

Claim 33 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ham in view of Brookner and Elgee. Applicant respectfully traverses these grounds of rejection at least in view of the following exemplary comments.

Independent claim 33 recites features similar to, although not necessarily coextensive with, the features argued above with respect to claim 24. Therefore, arguments presented with respect to claim 24 are respectfully submitted to apply with equal force here. As noted above, Brookner and Elgee do not compensate for the above-identified deficiencies of Ham. Accordingly, claim 33 is patentable over Ham in view of Brookner and Elgee.

VII. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

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